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EXAMINER
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HUSON, MONICA ANNE

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PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TASADDUQ HUSSAIN

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Appeal 2009-013244  
Application 10/675,622  
Technology Center 1700

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Before PETER F. KRATZ, BEVERLY A. FRANKLIN, and  
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 28-33, which are the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

We REVERSE.

Representative claim 29 reads as follows:

29. An injection blow molding machine having a turret with at least three planar faces, each of the planar faces carrying at least one hollow core rod, the turret being rotatable by an indexing motion to present each face, successively, at a plurality of stations to form, at one of said stations, a preform of an article on said at least one core rod at said one of said stations, and then to form, at a successive one of said stations, a blown article from said preform on said at least one core rod, and apparatus for cooling said at least one core rod at said one of said stations, said apparatus comprising:

a source of compressed air;

means for conditioning compressed air from said source;

means for circulating conditioned compressed air from said means for conditioning compressed air through said at least one core rod at said one of said stations; and

means for blocking circulation of compressed air from said means for conditioning compressed air through said at least one core rod at the successive one of said stations,

said means for circulating compressed air comprising means for exhausting compressed air from said at least one core rod at said one of said stations, and

wherein said means for blocking circulation of compressed air blocks the circulation of compressed air by blocking the exhaust of spent conditioned air from the successive one of said stations.

The Examiner maintains, and Appellant appeals, the following rejections under 35 U.S.C. § 103(a):

Claim 28<sup>2</sup> as being unpatentable over Gatti (US 4,668,177 issued May 26, 1987) or Farrell (US 3,998,577, issued Dec. 21, 1976), each combined with Martell (US 4,955,804, issued Sep. 11, 1990), Gasmire (US 3,065,501, issued Nov. 27, 1962), and Ikeda (US 5,817,348, issued Oct. 6, 1998);

Claims 29, 30, and 32 as being unpatentable over Gatti or Farrell, each combined with Martell, and Ikeda;

Claim 31 as being unpatentable over Gatti or Farrell, each combined with Martell, Ikeda, and Ryder (US 4,152,383, issued May 1, 1979); and

Claim 33 as being unpatentable over Gatti or Farrell, each combined with Martell, Ikeda, and Rosenkranz (US 4,076,071, issued Feb. 28, 1978).

#### OPINION

When the claim terms are written in a “means-plus-function” format, they must be interpreted as limited to the corresponding structures described in the specification or equivalents thereof consistent with 35 U.S.C. § 112, sixth paragraph. *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc).

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) *quoted with approval in KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

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<sup>2</sup> Independent claim 28 contains all of the limitations of independent claim 29 (App. Br. 4).

The fact finder must be aware “of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *KSR Int’l. Co.*, 550 U.S. at 421(citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 36 (1966) (warning against a “temptation to read into the prior art the teachings of the invention in issue”)).

Applying the preceding legal principles with respect to claim interpretation and obviousness to the factual findings in this record, we determine that the Examiner has not properly identified factual findings and reasoning for establishing a prima facie case of obviousness based on the applied prior art.

The deficiency of the Examiner’s obviousness conclusion is that

1) we find no indication on the record that the Examiner has properly considered the “means-plus-function” limitations in claims 28 and 29 with respect to the strictures of 35 U.S.C. § 112, sixth paragraph, since the “corresponding structure” in the Specification and “equivalents” thereof with respect to the means-plus-function limitations have not been determined in a manner consistent with the requirements of this statutory provision before applying the references to the claims. (*See Ans., e.g., 3-12.*) *See, e.g., Donaldson*, 16 F.3d at 1195 (“[T]he PTO was required by statute to look to Schuler's specification and construe the ‘means’ language recited in the last segment of claim 1 as limited to the corresponding structure disclosed in the specification and equivalents thereof.”)<sup>3</sup>;

2) even assuming *arguendo* that the Examiner has implicitly determined that the manual operable controls 86, 88 of Martell are equivalent to the cam plate 58, cam 60, and limit switch 62 which are

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<sup>3</sup> *See also, e.g., MPEP* §§ 2181-2185 (Rev. 6, Sept. 2007)

specified by Appellant to be the corresponding structure for the claimed “means for blocking circulation of compressed air” (*see, e.g.*, Ans. 3<sup>4</sup> “Martell . . . hence teaching that said controls (86, 88) block passage of cooling air upon zero volume output”; App. Br. 4), the Examiner has provided no evidentiary support nor technical reasoning for this determination of equivalent structure;

3) the flaw in the Examiner’s analysis of the means plus function language at issue is further exemplified by the Examiner’s determination that Ikeda is necessary since the combined prior art of Gatti, Martell, and Gasmire for claim 28 “do *not* teach means for blocking the exhaust system” (Ans. 4<sup>5</sup>; emphasis added) and likewise the combined prior art of Gatti and Martell for claim 29 “do *not* teach separate means for blocking circulation of compressed air separate from the means for conditioning the compressed air” (*e.g.*, Ans. 9<sup>6</sup>; emphasis added).

Accordingly, we agree with Appellant that the Examiner has not established that the three and four reference combinations to respectively reject independent claims 29 and 28 disclose or suggest “means for blocking circulation of such coolant through the core rod at one of the stations of the injection blow molding machine” (Reply Br. 2; *see also* claims 28, 29 “means for blocking circulation of compressed air from said means for conditioning compressed air”).

Under these circumstances, it is apparent that the only teaching or suggestion for combining the applied references in such a manner as to

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<sup>4</sup> The Answer page citations are of the replacement sections 8 and 9 of the Examiner’s Answer mailed by the Examiner on 02/09/2009.

<sup>5</sup> See footnote 3

<sup>6</sup> See footnote 3

achieve the here claimed invention derives from the Appellant's own Specification rather than the applied prior art. Therefore we conclude that, in addition to lacking an appropriate consideration of the claim limitations under 35 U.S.C. § 112, sixth paragraph, the Examiner's rejection is also improperly based upon improper hindsight reasoning. *See W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.").

None of the references applied in the remaining rejections have been relied upon by the Examiner to cure the deficiencies noted above.

On this record, we cannot say the Examiner has established a prima facie case of obviousness within the meaning of 35 U.S.C. § 103(a) for the claims on appeal. For these reasons and those set out in the Appeal Brief, we reverse all of the Examiner's § 103 rejections on appeal.

#### CONCLUSION

In summary, the rejections before us on appeal are reversed.

#### REVERSED

kmm

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